

Order 13175, Consultation and Coordination with Indian Tribal Governments, because it would not have a substantial direct effect on one or more Indian tribes, on the relationship between the Federal Government and Indian tribes, or on the distribution of power and responsibilities between the Federal Government and Indian tribes. We invite your comments on how this proposed rule might impact tribal government, even if that impact may not constitute a "tribal implication" under that Order.

Energy Effects

We have analyzed this proposed rule under Executive Order 13211, Actions Concerning Regulations That Significantly Affect Energy Supply, Distribution, or Use. We have determined that it is not a "significant energy action" under that order because it is not a "significant regulatory action" under Executive Order 12866 and is not likely to have a significant adverse effect on the supply, distribution, or use of energy. The Administrator of the Office of Information and Regulatory Affairs has not designated it as a significant energy action. Therefore, it does not require a Statement of Energy Effects under Executive Order 13211.

Environment

We have analyzed this proposed rule under Commandant Instruction M16475.ID, which guides the Coast Guard in complying with the National Environmental Policy Act of 1969 (NEPA) (42 U.S.C. 4321-4370f), and have made a preliminary determination that there are no factors in this case that would limit the use of a categorical exclusion under section 2.B.2 of the Instruction. Therefore, we believe that this rule should be categorically excluded, under figure 2-1, paragraph (34)(g), of the Instruction, from further environmental documentation.

Event participants swimming in the water pose no inherent risk to the surrounding environment, and a safety zone is needed to protect the participants. Under figure 2-1, paragraph (34)(g), of the Instruction, an "Environmental Analysis Check List" is not required for this rule. Comments on this section will be considered before we make the final decision on whether to categorically exclude this rule from further environmental review.

List of Subjects in 33 CFR Part 165

Harbors, Marine safety, Navigation (water), Reporting and recordkeeping requirements, Security measures, Waterways.

For the reasons discussed in the preamble, the Coast Guard proposes to amend 33 CFR part 165 as follows:

PART 165—REGULATED NAVIGATION AREAS AND LIMITED ACCESS AREAS

1. The authority citation for part 165 continues to read as follows:

Authority: 33 U.S.C. 1226, 1231; 46 U.S.C. Chapter 701; 50 U.S.C. 191, 195; 33 CFR 1.05-1(g), 6.04-1, 6.04-6, and 160.5; Pub. L. 107-295, 116 Stat. 2064; Department of Homeland Security Delegation No. 0170.1.

2. Add § 165.922 to read as follows:

165.922 Safety Zone; Cleveland Triathlon Swimming Event in the Captain of the Port Cleveland Zone.

(a) *Location.* The following area is a safety zone:

(1) All waters in Cleveland Harbor, to include the North Coast Harbor, originating at a line drawn from Pier 32, at position 41°30'36" N, 081°42'56" W, extending to position 41°30'43" N, 081°42'03" W, thence to Buoy 11 (LLNR 4135) at position 41°30'49" N, 081°41'53" W in Cleveland Harbor, thence to the Northeast corner of Municipal Pier at position 41°30'43" N, 081°41'47" W. These coordinates are based upon North American Datum 1983 (NAD 83).

(b) *Enforcement Period.* This safety zone will be enforced from 5 a.m. (local) until 11 a.m., annually on the third Sunday of July.

(c) *Regulations.* No vessel shall enter the safety zone. Permission to deviate from the above rules must be obtained from the Captain of the Port or the on-scene Coast Guard Patrol Commander via VHF/FM radio, Channel 16 or by telephone at 216-937-0111.

Dated: March 28, 2005.

Lorne W. Thomas,

Commander, U.S. Coast Guard, Captain of the Port Cleveland.

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 3, and 10

[Docket No.: 2005-P-053]

RIN 0651-AB85

Provisions for Persons Granted Limited Recognition To Prosecute Patent Applications and Other Miscellaneous Matters

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) is proposing changes to the rules of practice concerning persons acting with limited recognition in a patent matter, the filing of the English translation of foreign-language provisional applications, and the submission of evidence ownership when an assignee takes action in a patent matter. The Office is proposing changes to the rules of practice to allow a person acting with limited recognition to be given a power of attorney and authorized to sign amendments and other correspondence respecting patent applications, reexamination proceedings, and other proceedings. A person granted limited recognition is not a registered patent attorney or agent. The Office is also proposing changes to the rules of practice to require that a copy of the English translation of a foreign-language provisional application be filed in the provisional application (rather than in either the provisional application or the nonprovisional application) if a non-provisional application claims the benefit of the provisional application. In addition, the Office is proposing changes to require that a copy of documentary evidence of ownership be recorded in the Office's assignment records when an assignee takes action in a patent matter, and that separate copies of a document be submitted to the Office for recording in the Office's assignment records, each accompanied by a cover sheet, if the document to be recorded includes an interest in, or a transaction involving, both patents and trademarks.

DATES: To be ensured of consideration, written comments must be received on or before June 6, 2005. No public hearing will be held.

ADDRESSES: Comments should be sent by electronic mail over the Internet addressed to:

AB85.comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; or by facsimile to (703) 273-7744, marked to the attention of Karin Ferriter. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3 1/2-inch disk accompanied by a paper copy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking

Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

The comments will be available for public inspection at the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, currently located at Room 7D74 of Madison West, 600 Dulany Street, Alexandria, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT:

Karin Ferriter ((571) 272-7744), Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy; Harry I. Moatz ((571) 272-4097), Director of the Office of Enrollment and Discipline (OED Director); or Robert J. Spar ((571) 272-7700) Director of the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, directly by phone, or by facsimile to (571) 273-7744, or by mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: This notice proposes changes in the rules of practice in title 37 of the Code of Federal Regulations (CFR) pertaining to the availability of patent application files, persons acting with limited recognition in a patent matter, the filing of the English translation of foreign-language provisional applications, and the submission of evidence ownership when an assignee takes action in a patent matter and for recording in the Office's assignment records. The proposed changes concerning the availability of patent application files relate to § 1.11. The proposed changes concerning persons acting with limited recognition in a patent matter relate to §§ 1.4, 1.17, 1.31, 1.32, 1.33, 1.34, and 1.36. The proposed changes concerning the filing of the English translation of foreign-language provisional applications relate to § 1.78. The proposed changes concerning the submission of evidence ownership when an assignee takes action in a patent matter and for recording in the Office's assignment records relate to §§ 3.28, 3.31, 3.73, and 10.112.

Discussion of Specific Rules

Section 1.4: The title is proposed to be revised to read: "Nature of correspondence and Signature Requirements." Section 1.4(d)(2) is proposed to be revised to delete "with a signature in permanent dark ink or its equivalent," because dark ink applies to handwritten signatures, not S-signatures. Section 1.4(d)(2)(ii) is proposed to be revised to change "registered practitioner" to "patent practitioner (§ 1.32(a)(1))" and to insert "or limited recognition number" after "registration number" in two places so that a person acting with limited recognition can use an S-signature. The term "patent practitioner" is defined in § 1.32(a).

Section 1.11: Section 1.11(a) is proposed to be revised for clarity and to reflect the policy regarding availability to the public of papers in the files of applications that have been published. For example, § 1.11(a) is proposed to be revised to remove "abandoned" before "published application." Published applications are not physically available to the public if the file was maintained in a paper file wrapper, but any electronic file relating to a published application is made available through the Patent Application Information Retrieval (PAIR) system pursuant to § 1.14(a)(1)(iii) and 1.14(b). Since most pending applications are now available through PAIR, the reference to only abandoned published applications in § 1.11 may have been misleading. In addition, § 1.11(a) is proposed to be revised to include: "If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents of the patent application will not be available if: The requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and the application is still pending."

Section 1.17: Section 1.17(f) is proposed to be revised to add "§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants." See the discussion of the proposed change to § 1.36(a). This proposed change would correct § 1.17 by including § 1.36(a) in the list of petitions for which a fee set forth in § 1.17 can be charged, and also groups the fee for a petition under § 1.36(a) with similar petitions (under § 1.182 and § 1.183).

Section 1.31: Section 1.31 is proposed to be revised to change the title to "Applicants may be represented by one or more patent practitioners or joint inventors" in order to make the title of the rule more descriptive of the

proposed revised rule. A definition for "patent practitioner" is proposed to be added to § 1.32(a), as discussed below, and the term "patent practitioner" is proposed to be used in place of "registered patent attorney or agent" in § 1.31, and in other rules. Further, § 1.31 is proposed to be revised to indicate that one or more patent practitioners or joint inventors may be given a power of attorney, to thereby recognize that there may be a single person appointed or an appointment of more than one practitioner or joint inventor to represent the applicant. Section 1.32(c)(1) permits one or more joint inventors to be given power of attorney to represent the other joint inventor or inventors; accordingly, the revision to § 1.31 is necessary for consistency with § 1.32(c)(1). Furthermore, § 1.31 is proposed to be amended to delete the cross references to §§ 11.6 and 11.9, which would no longer be useful in view of the definition of patent practitioner proposed to be added to § 1.32(a).

Section 1.32: Section 1.32(a)(1) is proposed to be revised to set forth the definition of "patent practitioner" and to renumber sections (a)(1) to (a)(4) as (a)(2) through (a)(5), respectively.

Proposed new § 1.32(a)(1) defines the term "patent practitioner" as "a registered patent attorney or registered patent agent under § 11.6, or individual granted limited recognition to file or prosecute a patent application, or other patent proceeding, before the United States Patent and Trademark Office under § 11.9(a) or § 11.9(b)." This definition is consistent with the definition of "practitioner" in § 11.1 as "(1) An attorney or agent registered to practice before the Office in patent matters* * * or (3) An individual authorized to practice before the Office in a patent case or matters under § 11.9(a) or (b)." A person with limited recognition pursuant to § 11.9(a) and § 11.9(b) is not a registered patent practitioner, but is someone who has been given limited recognition to prosecute a patent application. Individuals granted limited recognition pursuant to § 11.9(a) are given such recognition for one or more specified patent applications or other patent proceedings. For example, a parent or spouse may be given limited recognition to represent the inventor where the inventor is competent and 35 U.S.C. 117 and § 1.43 do not apply. Limited recognition pursuant to § 11.9(b) is granted to individuals who have passed the patent examination and are U.S. residents, but are neither citizens of the U.S. nor permanent residents and thus are not eligible to become registered.

Because these individuals have a visa to work in the U.S., they are accorded limited recognition consistent with the visa. The term "patent practitioner" is limited to those that are registered or authorized by the Office to act in patent matters.

Section 1.32(a)(1) is proposed to be renumbered as § 1.32(a)(2) and further revised to change "registered patent attorneys or registered patent agents" to "one or more patent practitioners or joint inventors" to reflect that one, or more than one, patent practitioner may be appointed in a power of attorney. Section 1.32(c) permits a power of attorney to be to one or more patent practitioners or joint inventors, and this change is consistent therewith.

Section 1.32(a)(2) is proposed to be renumbered as § 1.32(a)(3) and further revised to add "or, in a reexamination proceeding, the assignee of the entirety of ownership of a patent" to reflect that the assignee of the entire interest in a patent may authorize a patent practitioner to represent the assignee in reexamination proceedings, for example, in addition to patent applications. In addition, § 1.32(a)(3) is proposed to be revised to change "registered patent attorney or registered patent agent" to "patent practitioners" and "joint inventor" to "joint inventors." As explained above, use of the term "patent practitioner" expands the rule to also apply to individuals granted limited recognition to file (present) or prosecute a patent application or other patent proceeding before the United States Patent and Trademark Office, as well as registered patent attorneys and registered patent agents.

Section 1.32(a)(3) is proposed to be renumbered as § 1.32(a)(4), and further proposed to be revised to change "registered patent attorney or registered patent agent" to "patent practitioner or joint inventor."

Section 1.32(a)(4) is proposed to be renumbered as § 1.32(a)(5), and the resulting new paragraph § 1.32(a)(5)(i) is proposed to be revised to change "patent application or patent" to "patent application, patent or other patent proceeding" and the resulting new paragraph 1.32(a)(5)(iii) is proposed to be revised to delete "registered."

Section 1.32(c)(3) is proposed to be revised such that the first sentence reads: "Ten or fewer patent practitioners, stating the name and registration number or limited recognition number of each patent practitioner." The Office needs the registration number of the patent practitioner to make the practitioner of

record. Because the former rules did not require a registration number, registration numbers were sometimes omitted, leading to delays in Office processing of powers of attorney. Accordingly, § 1.32(c)(3) is proposed to be amended to add a requirement for the registration number or limited recognition number of the patent practitioner to assist the Office in making the practitioner of record. Limited recognition numbers recently began to be assigned by the Office of Enrollment and Discipline.

Section § 1.33: Section 1.33(a) is proposed to be revised to use the generic term "patent practitioner" instead of "registered patent attorney or patent agent" so as to also include those acting with limited recognition. Specifically, § 1.33(a) is proposed to be amended to change "registered patent attorney or patent agent" to "patent practitioner" in two places. In addition, § 1.33(a)(1) is proposed to be amended to change "If the application was filed by a registered attorney or agent, any other registered practitioner named in the transmittal papers may also change the correspondence address" to "If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address."

Section 1.33(b)(1) and § 1.33(b)(2) are proposed to be amended to change "registered patent attorney or patent agent" to "patent practitioner."

Section 1.33 is also proposed to be revised to add new paragraph (e) to remind patent practitioners that the attorney roster must be updated separately from individual patent applications. Section 1.33 is proposed to be revised to state: "(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § 11.11 of this part."

Section 1.34: Section 1.34 is proposed to be revised to change "registered patent attorney or patent agent" to "patent practitioner" in two places, and change "must specify his or her registration number and name with his or her signature" to "must set forth his or her registration number, or limited recognition number, and his or her name and signature" in order to provide support for someone accorded limited recognition to act in a representative capacity.

Section 1.36: Section 1.36(a) is proposed to be revised to change § 1.17(h) to § 1.17(f). The fee for a petition to allow a split power of attorney should be the same regardless

of whether the split power of attorney results from revocation by fewer than all of the inventors, as provided in § 1.36(a), or from a petition under § 1.183 to waive the provisions of § 1.32(b)(4) requiring that a power of attorney be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant. Furthermore, "registered patent attorney or patent agent" is proposed to be changed to "patent practitioner."

Section 1.78: Section 1.78(a)(2)(i) is proposed to be revised to add ", or international application designating the United States of America," to require international applications to contain a specific reference to the earlier nonprovisional application.

Section 1.78(a)(5)(iv) is proposed to be revised to require the English translation of a provisional application to be filed in a provisional application, instead of also permitting the translation to be filed in each nonprovisional application that claims the benefit of the filing date of the provisional application. Section 1.78(a)(5)(iv) is also proposed to be revised to provide that applicant must file, in a nonprovisional application, confirmation of the filing of the translation and statement, when a notice is mailed in the nonprovisional application requiring the translation and statement. Currently, § 1.78(a)(5)(iv) provides that when, pursuant to 35 U.S.C. 119(e), benefit is being claimed to a provisional application which was filed in a language other than English, an English language translation of the provisional application, accompanied by a statement that the translation is accurate, must be filed in either: (a) the provisional application or (b) each nonprovisional application that claims the benefit of the provisional application. Thus, if the translation and statement are not filed in the provisional application, they may be filed in each application that claims the benefit of the filing date of the provisional application (to satisfy the requirement of the rule). A provisional application is open to the public if the benefit of the provisional application is claimed in an application that has either been published or patented. Where the translation and statement are not filed in the provisional application because they are filed in each nonprovisional application(s) claiming the benefit of the provisional application, there is a burden on the public in finding the translation and statement, and to the Office in storing possibly duplicate copies of the documents. Further, when a translation of the provisional application is filed in the nonprovisional application, the Office

has sometimes confused the translation of the provisional with the specification papers to be used for the application. Since the option is available to file the translation and statement in the nonprovisional application, applicant's counsel may inadvertently choose that option in situations where there are many nonprovisional applications claiming the benefit of a single provisional application, and incur substantial expense for having to file a copy in each nonprovisional application. Having only one copy of the translation (and statement) "centrally" filed in the provisional application, regardless of how many nonprovisional applications claim benefit of that provisional application, would be beneficial for applicants, the public, and the Office. Accordingly, § 1.78(a)(5)(iv) is proposed to be revised to delete from the first sentence "or the later-filed nonprovisional application" to thereby eliminate the option to file the translation and statement in the nonprovisional application. Furthermore, § 1.78(a)(5)(iv) is further proposed to be revised to add ", in the provisional application," after "a period of time within which to file." Lastly, the last sentence of § 1.78(a)(5)(iv) is further proposed to be revised to read "If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing of a confirmation in the nonprovisional application that the translation and statement were filed in the provisional application or the nonprovisional application will be abandoned."

Section 3.28: Section 3.28 currently directs that "[o]nly one set of documents and cover sheets to be recorded should be filed" which discourages assignees from submitting one set of documents including a patent cover sheet and the document to be recorded, and another set of documents including a trademark cover sheet and another copy of the document to be recorded. While the Office can process a set of documents that includes a patent cover sheet, trademark cover sheet, and only one copy of the document to be recorded, submitting only one copy of the document can lead to the misconception that a document submitted for recordation has been omitted, or the document submitted only belongs to the second cover sheet, particularly when the documents are submitted by facsimile and there is a break in the transmission. For example, if a submission includes: a trademark sheet on pages 1 and 2, a patent cover sheet on page 3, and a document for

recording on pages 4–7, then, if pages 1 and 2 are separated from the remainder of the set of documents, it may not be clear that the trademark cover sheet is missing since the patent cover sheet and the document to be recorded would have themselves made a complete set of documents. To reduce confusion, it is proposed to revise § 3.28 to require that a separate copy of the document to be recorded be submitted with each cover sheet. Note that even if the term "copy of the document to be recorded" is not used in this discussion, the document submitted for recordation must be a copy, and not the original document, and the term "document to be recorded" has been used to emphasize that the document is to be recorded, not to suggest that an original may be submitted.

Section 3.28 is proposed to be revised to state that each document to be recorded must be accompanied by a single cover sheet (and not multiple cover sheets), to put parenthesis around "as specified in § 3.31," and to delete the statement that at least one cover sheet must be included with each document submitted for recording. Section 3.28 is also proposed to be revised to delete the sentence that states that only one set of documents and cover sheets to be recorded should be filed, and to make it clear that if an assignment includes interests in, or transactions involving, both patents and trademarks, then two copies of each document (each document with its own cover sheet) would have to be submitted. Thus, a patent cover sheet and a copy of the document, and a trademark cover sheet and a copy of the document, would be submitted.

Section 3.31: Section 3.31(a)(7) is proposed to be amended to delete "submission" before "(e.g./Thomas O'Malley III/)" to correct an obvious error.

Section 3.73: Section 3.73(b)(1)(i) is proposed to be revised to require, for patent matters, that the document(s) submitted to establish ownership under § 3.73(b) be recorded pursuant to § 3.11 in the assignment records.

In order to take action in a patent application or a patent, a party must comply with § 3.73 to establish ownership of the rights to a patent application or a patent (*i.e.*, a patent property) by submitting to the Office a signed statement identifying the assignee. The signed statement must be accompanied by either: (i) Documentary evidence of a chain of title from the original owner to the assignment, or (ii) a statement specifying where such documentary evidence is recorded in the Office's assignment records. Where

option (i) is chosen, there is no requirement that the document(s) submitted to establish ownership also be recorded pursuant to § 3.11 in the assignment records, unless the Office explicitly requires such recordation on a case-by-case basis. Such a requirement is made only in the rare situation where a question arises as to ownership of the property. It is desirable, however, that the Office's patent assignment records should, as a rule, reflect the assignment of any assignee seeking to take action in a patent application or patent. The current system which permits an assignee to take action by submitting a copy of the assignment in a patent application or patent, but not requiring the assignment to be recorded in the Office's patent assignment records, makes a search of the Office's patent assignment records unreliable. Permitting an assignee to take action in an application or patent without also recording the assignment (in the Office's assignment records) can also serve to discourage an assignee from recording its assignment document(s), and thus lose the right to rely upon recordation pursuant to 35 U.S.C. 261 ("An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.")

Section 3.73(b)(1)(i) is proposed to be revised to require that the submission of the documentary evidence to establish ownership must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was submitted for recordation pursuant to § 3.11. Thus, when filing a § 3.73(b) statement to establish ownership an applicant or patent owner must also submit the assignment document(s) to the Office for recordation, if such a submission has not been previously made. If the § 3.73(b) statement is not accompanied by a statement affirming that the documentary evidence was submitted for recordation pursuant to § 3.11, then the § 3.73(b) statement will not be accepted, and the assignee(s) will not have established the right to take action in the patent application or the patent for which the § 3.73(b) statement was submitted. For trademark matters, there would continue to be no requirement that the submission of the documentary evidence be accompanied by a statement affirming that the documentary evidence was submitted

for recordation. Rather, paragraph (b)(1)(i) would continue to set forth that the Office may require (as deemed appropriate in any individual case) the documents submitted to establish ownership to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office.

Section 10.112: Section 10.112 is proposed to be revised to correct the cross reference, changing “10.6(c)” to “11.6(c).”

Rule Making Considerations

Administrative Procedure Act: The changes proposed in this notice (except for the petition fee change for a split power of attorney resulting from revocation of the power of attorney by fewer than all of the applicants or assignees of the applicants) relate solely to the procedures to be followed during the prosecution of a patent application. Specifically, the changes proposed in this notice concern: (1) Providing the proper S-signature by someone acting with limited recognition pursuant to § 11.9(a) and § 11.9(b); (2) providing for a power of attorney to a person acting with limited recognition pursuant to § 11.9(a) and § 11.9(b); (3) providing that the petition fee for a split power of attorney resulting from revocation of the power of attorney by fewer than all of the applicants or assignees of the applicants be the same as the petition fee to waive the rules to appoint a split power of attorney initially; (4) requiring that the translation of a non-English language provisional application and statement that the translation is accurate be filed in a provisional application, rather than either the nonprovisional application claiming the benefit of the provisional application or the provisional application; and (5) requiring that the evidentiary evidence of ownership be recorded under 37 CFR part 3 when an assignee takes action in a patent application. Therefore, these rule changes involve interpretive rules, or rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are “rules of agency organization, procedure, or practice” and are exempt from the Administrative Procedure Act’s notice and comment requirement); *see also Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549–50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) (the rules of practice promulgated under the authority of former 35 U.S.C. 6(a) (now in 35 U.S.C. 2(b)(2)) are not substantive rules to which the notice and comment

requirements of the Administrative Procedure Act apply), and *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995) (“it is doubtful whether any of the rules formulated to govern patent and trade-mark practice are other than ‘interpretative rules, general statements of policy, * * * procedure, or practice.’”) (quoting C.W. Ooms, *The United States Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 153 (1948)).

Regulatory Flexibility Act: Prior notice and an opportunity for public comment were not required pursuant to 5 U.S.C. 553 (or any other law) for the procedural changes proposed in this notice. Therefore, an initial regulatory flexibility analysis under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is not required for those changes proposed in this notice (with the sole exception of the change to the petition fee for revocation of a power of attorney by fewer than all of the applicants). *See* 5 U.S.C. 603.

With respect to the petition fee change, the proposed rule will increase the petition fee for revocation of a power of attorney by fewer than all of the applicants. This notice proposes to change the petition fee (from the \$130.00 fee specified in § 1.17(h) to the \$400.00 fee specified in § 1.17(f) in situations where a split power of attorney results from revocation of the power of attorney by fewer than all of the applicants or assignees of the applicants. The proposed rule will bring the fees in line with the actual cost of treating such petitions (in view of the special handling required for the split power of attorney resulting from revocation of the power of attorney). This petition fee is established pursuant to the Office’s authority under 35 U.S.C. 41(d) to establish fees for all processing, services, or materials relating to patents not otherwise specified in 35 U.S.C. 41 to recover the estimated average cost to the Office of such processing, services, or materials.

The Office received over 376,000 nonprovisional patent applications and over 102,000 provisional patent applications in fiscal year 2004. The Office receives fewer than five petitions for revocation of the power of attorney by fewer than all of the applicants or assignees of the applicants each year. On this basis alone, the fee change will not have an impact on a substantial number of small businesses. While the Office does not track the entity status of such petitions, the small entity patent application filing rate has not been greater than 31.0% during the last five fiscal years. Thus, this proposed change (even if all of the affected patents were

by a small entity) would impact no more than two small entities in any calendar year.

Accordingly, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

Executive Order 13132: This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866: This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act: This notice involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collection of information involved in this notice has been reviewed and previously approved by OMB under OMB control number 0651–0012, 0651–0027, 0651–0031, 0651–0032, and 0651–0035. The United States Patent and Trademark Office is not resubmitting any information collection package to OMB for its review and approval because the changes in this notice do not affect the information collection requirements associated with the information collection under these OMB control numbers. The principal impacts of the changes proposed in this notice are: (1) Providing for the proper S-signature by someone acting with limited recognition pursuant to § 11.9(a) and § 11.9(b); (2) providing for power of attorney to a person acting with limited recognition pursuant to § 11.9(a) and § 11.9(b); (3) providing that the fee for a split power of attorney resulting from revocation of the power of attorney by fewer than all of the applicants or assignees of the applicants be the same as the fee to waive the rules to appoint a split power of attorney initially; (4) requiring that the translation of a non-English language provisional application and statement that the translation is accurate be filed in a provisional application, rather than either the nonprovisional application claiming the benefit of the provisional application or the provisional application; and (5) requiring that the evidentiary evidence of ownership be recorded under 37 CFR part 3 when an

assignee takes action in a patent application.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10235, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small businesses.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and record keeping requirements.

For the reasons set forth in the preamble, 37 CFR parts 1, 3, and 10 are proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.4 is amended by revising paragraph (d)(2) introductory text, and paragraph (d)(2)(ii) to read as follows:

§ 1.4 Nature of correspondence and Signature Requirements.

* * * * *

(d) * * *

(2) S-signature. An S-signature is a signature inserted between forward slash marks, but not a handwritten

signature as defined by § 1.4(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by either a handwritten signature of § 1.4(d)(1) or an Office Electronic Filing System (EFS) character coded signature of § 1.4(d)(3). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the Office Electronic Filing System as an EFS Tag(ged) Image File Format (TIFF) attachment, for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (i.e., with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) are as follows.

* * * * *

(ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number or limited recognition number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may only be used as part of the S-signature when appearing before a practitioner's registration number or limited recognition number; otherwise the number character may not be used in an S-signature.

* * * * *

3. Section 1.11 is amended by revising paragraph (a) to read as follows:

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of: a published application; a patent; or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). If an application was published in redacted form pursuant to § 1.217, the complete file wrapper and contents of the patent application will not be available if: the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of § 1.217 have been met in the application; and the application is still pending. See § 2.27 for trademark files.

* * * * *

4. Section 1.17 is amended by revising paragraph (f) to read as follows:

§ 1.17 Patent application and reexamination processing fees.

* * * * *

(f) For filing a petition under one of the following sections which refers to this paragraph: \$400.00.

§ 1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§ 1.53(e)—to accord a filing date.

§ 1.57(a)—to accord a filing date.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

* * * * *

5. Section 1.31 is revised to read as follows:

§ 1.31 Applicants may be represented by one or more patent practitioners or joint inventors.

An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney so as to be represented by one or more patent practitioners or joint inventors. The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

6. Section 1.32 is amended by revising paragraphs (a) and (c)(3) to read as follows:

§ 1.32 Power of attorney.

(a) Definitions—(1) Patent practitioner means a registered patent attorney or registered patent agent under § 11.6 of this chapter, or an individual granted limited recognition to file or prosecute a patent application, or other patent proceeding, before the United States Patent and Trademark Office under § 11.9(a) or § 11.9(b).

(2) Power of attorney means a written document by which a principal authorizes one or more patent practitioners or joint inventors to act on his or her behalf.

(3) Principal means either an applicant for patent (§ 1.41(b)) or an assignee of entire interest of the applicant for patent or in a reexamination proceeding, the assignee of the entirety of ownership of a patent. The principal executes a power of attorney designating one or more patent practitioners or joint inventors to act on his or her behalf.

(4) Revocation means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on his or her behalf.

(5) Customer Number means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§ 1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

* * * * *

(c) * * *

(3) Ten or fewer patent practitioners, stating the name and registration number or limited recognition number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

7. Section 1.33 is amended by revising paragraphs (a) introductory text, (a)(1), (b)(1) and (b)(2) and by adding paragraph (e) to read as follows:

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will establish one as the correspondence address and will use the address associated with a Customer Number, if given, over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be

supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

* * * * *

(b) * * *

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

* * * * *

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See § 11.11 of this chapter.

8. Section 1.34 is revised to read as follows:

§ 1.34 Acting in a representative capacity.

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, or limited recognition number, and his or her name and signature. Further proof of authority to act in a representative capacity may be required.

9. Section 1.36 is amended by revising paragraph (a) to read as follows:

§ 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.

(a) A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceedings of a case by an

applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest of a patent. A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the applicants (or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

* * * * *

10. Section 1.78 is amended by revising paragraphs (a)(2)(i) and (a)(5)(iv) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) * * *

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, or international application designating the United States of America, claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

* * * * *

(5) * * *

(iv) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file, in the provisional application, an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing of a confirmation in the nonprovisional application that the translation and statement were filed in the provisional application or the nonprovisional application will be abandoned.

* * * * *

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

11. The authority citation for 37 CFR part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

12. Section 3.28 is revised to read as follows:

§ 3.28 Requests for recording.

Each document submitted to the Office for recording must include a single cover sheet (as specified in § 3.31) referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, then separate patent and trademark cover sheets, each accompanied by a copy of the document to be recorded, should be submitted. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion, in which case the document and a completed cover sheet should be resubmitted.

13. Section 3.31 is amended by revising paragraph (a)(7)(i) to read as follows:

§ 3.31 Cover sheet content.

- (a) * * *
- (7) * * *

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks (*e.g.*

/Thomas O'Malley III/) in the signature block on the electronic submission; or

* * * * *

14. Section 3.73 is amended by revising paragraph (b)(1)(i) to read as follows:

§ 3.73 Establishing right of assignee to take action.

* * * * *

(b)(1) * * *

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was submitted for recordation pursuant to § 3.11; or

* * * * *

PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

15. The authority citation for 37 CFR part 10 continues to read as follows:

Authority: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 2, 6, 32, 41.

16. Section 10.112 is amended by revising paragraph (a) to read as follows:

§ 10.112 Preserving identity of funds and property of client.

(a) All funds of clients paid to a practitioner or a practitioner's firm, other than advances for costs and expenses, shall be deposited in one or more identifiable bank accounts maintained in the United States or, in the case of a practitioner having an office in a foreign country or registered under § 11.6(c), in the United States or the foreign country.

* * * * *

Dated: April 1, 2005.

Jon W. Dudas,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 05-6931 Filed 4-6-05; 8:45 am]

BILLING CODE 3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. 2005-T-056]

RIN 0651-AB88

Requirements To Receive a Reduced Fee for Filing an Application Through the Trademark Electronic Application System

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rule making.

SUMMARY: The United States Patent and Trademark Office (Office) proposes to amend its rules to permit an applicant using the Trademark Electronic Application System (TEAS) to file a trademark or service mark application for registration on the Principal Register under section 1 and/or 44 of the Act to pay a reduced fee under certain circumstances. The Office proposes to offer a reduced fee to TEAS applicants if the application meets certain filing requirements beyond those required to receive a filing date. The applicant must also respond to Office actions within two months of the mailing date, file communications regarding the application through TEAS, and agree to receive communications concerning the application by electronic mail (e-mail). TEAS applications that qualify for the reduced fee option will be referred to as "TEAS Plus" applications. The reduced fee option will not apply to applications filed pursuant to section 66(a) of the Act because they cannot be filed through TEAS.

DATES: Comments must be received by May 9, 2005 to ensure consideration.

ADDRESSES: Submit comments by e-mail to: *TEASPLUS.comments@uspto.gov*.

Written comments may be submitted by mail to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, attention Cheryl L. Black; or by hand delivery to: Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cheryl L. Black.

FOR FURTHER INFORMATION CONTACT:

Cheryl L. Black, Office of the Commissioner for Trademarks, by telephone at (571) 272-9565, by e-mail to *cheryl.black@uspto.gov*, or by facsimile at (571) 273-9565.

SUPPLEMENTARY INFORMATION: The Office proposes to offer a reduced fee to TEAS applicants using the Office's